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Total number of pages (including this one): 10

In case of missing or illegible pages, please inform Haviv Toledano by
e-mail to: a.toledano@netcourrier.com
or by telephone number (+) 33 1 42 02 07 23

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Applicant: Haviv Toledano

Serial N°: 10/009,138

Filed: 26 November 2001

For: A flexible Annular Stapler for Closed Surgery of Hollow Organs

Examiner: Thomas McEvoy

Mail Stop PCT
Commissioner for Patents
Office of PCT Legal Administration
P.O. Box 1450, Alexandria, Virginia 22313-1450

Attention: Mr Richard Cole
Senior Legal Examiner
Office of PCT Legal Administration.
FAX: (+) 571-273-0459

December 16th, 2010

Dear Mr Cole,

I'm sending this mail to ask for your help in solving a (an administrative?) problem that has arisen concerning the priority claim of my application N° 10/009,138 , a problem raised by the actual USPTO Examiner of that application (10/009,138).

I would like to remind you that you handled the above application filed on 26 November 2001 and for which, I –as the applicant/inventor- was later sent a **first filing receipt** mailed 31 January 2003 that said:

"This application is a 371 of PCT/IB97/00887 filed 07/17/1997".

Some fourteen months later (on March 2004), you made the decision of vacating said **first filing receipt** (of 31 January 2003) for reasons explained in your letter dating 16 March 2004. My application 10/009,138 was hence reforwarded to the USPTO's office of processing for new processing in accordance with the decision you made as detailed in your March 16, 2004 letter.

A **second filing receipt** mailed to the applicant on November 30, 2004, mentioned:

"This application is a DIV of 09/214,039 filed 12/28/1998 ABN which is a 371 of PCT/IB97/00887 filed 07/17/1997".

On said **second filing receipt** (of 11/30/2004), the processing Officer of USPTO neglected to specify that application N° 09/214,039 (filed on 12/28/1998) had been continued (before its abandonment) in a Continuing Prosecution Application (CPA) which was filed when 09/214,039 was still pending on 05/02/2001. For said CPA, the USPTO processing Officer gave a new official application number (= 09/846,362) and a new official filing date (=05/02/2001) while in fact, in that specific case, he shouldn't have changed nor the application number nor the filing date because CPA 09/846,362 was identical to its "parent application" 09/214,039.

It is obvious that the problem I am facing now wouldn't have arisen if the first filing receipt mailed January 31, 2003 hadn't been modified as a consequence of its vacation.

To be more specific: Since the CPA doesn't figure on said second filing receipt as it should have, and instead it only states the fact that application 09/214,039 has been abandoned, the actual USPTO Examiner claims that the chain of pendencies between the prior filed applications and present one (10/009,138) is not hence respected. Consequently, I've received a "before final" Office Action on June 12, 2008 and a "final" Office Action on October 27, 2010, rejecting all the claims of present application 10/009,138 just on the grounds of being anticipated by my own original and parent prior filed applications (08/687,315 ; 09/214,039 ; 09/846,362). That, in contradiction to patent rule 35 U.S.C. 121 that says that original and parent applications cannot "be used as a reference either in the Patent Trademark Office or in the courts against divisional application or against the original application or any patent issued on either of them". Moreover, the USPTO examiner believes that I have to file a petition under 37 CFR 1.78(a) and pay a surcharge (of 1420 USD) under 37 CFR 1.17(t) in order to reinstate my rights. This of course doesn't seem to me justified at all for the following reasons:

- (1) The applicant should not be held as responsible for errors made by the processing officer of the USPTO.
- (2) The whole matter concerning present application was close at hand and nothing was hidden from the USPTO Officer since the beginning of the procedure.
- (3) Following the before final Office Action dating June 12, 2008, I have amended the present application 10/009,138 by adding immediately after the title of the application the following sentences: "This application is a division of US patent application Ser. N. 09/214,039 filed on December 28, 1998, which was assigned the serial N. 09/846,362 in its Continued Prosecution Application (CPA) on May 2, 2001. Said application N. 09/214,039 which is a National stage of International application N. PCT/IB97/00887 filed on July 17, 1997, is also a division of US application N. 08/687,315 filed on July 25, 1996"
- (4) Application 10/009,138 which has received in USPTO the filing date November 26, 2001 included –with the specification on the same date–:
 - a) A declaration claiming the priority of:

*PCT/IB/00887 filed 17 July 1997 (under Title 35, US Code, §119)

*08/687,315 filed 25 July 1996 (under Title 35, US Code, §120)

*09/846,362 (which is the CPA of 09/214,039) filed 2 May 2001 (also under Title 35, US Code, § 120).

- b) A preliminary amendment in which it was clearly indicated in the opening statement of the remarks that present application 10/009,138 was a divisional application of earlier filed applications with the links to the prior filed applications including the fact that application 09/846,362 was a CPA of application N° 09/214,039.
- (5) Present application (10/009,138) is "a non provisional application which entered the national stage after compliance with 35 U.S.C. 371 from an international application before November 29, 2000". It is reminded that PCT/IB97/00887 was filed on July 1997, therefore the petition and surcharge evocated by the Examiner are not considered relevant in this case pursuant to 37 CFR 1.78 (a)(2)(ii)(C).

Since your letter dating 16 March 2004 confirms all the above facts, could you please help me solve all the imbroglio caused by the USPTO processing office?

Your prompt answer would be very much appreciated since there isn't much time left due to the short deadlines.

Very Sincerely

Haviv Toledano



16 MAR 2004



UNITED STATES PATENT and TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. Box 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

Haviv Toledano
c/o Davud Netznab
693 Downing Street
Teaneck, NJ 07666

In re Application of :
Toledano. :
Application No.: 10/009,138 :
Filing Date: 26 November 2001 : DECISION
For: A FLEXIBLE ANNULAR STAPLER FOR :
CLOSED SURGERY OF HOLLOW ORGANS :
:

This decision is before the PCT Legal Office for matters arising under 35 U.S.C. 371.

BACKGROUND

On 17 July 1997, applicant filed international application PCT/IB97/00887 that claimed priority of an earlier United States application which was filed 25 July 1996. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 05 February 1998. A Demand for international preliminary examination was timely filed 09 February 1998. Accordingly, the thirty-month period for paying the basic national fee for the national stage in the United States expired at midnight on 25 January 1999.

On 26 November 2001, applicant filed a Transmittal Letter (Form PTO-1390) for entry into the national stage in the United States which was accompanied by, *inter alia*, a copy of the application, a preliminary amendment and the basic national fee as required by 35 U.S.C. 371(c). These papers were assigned application number 10/009,138.

On 31 January 2003, the United States Patent and Trademark Office (USPTO) in its capacity as an Elected Office mailed out a "NOTIFICATION OF ACCEPTANCE OF APPLICATION UNDER 35 U.S.C. 371 AND 37 CFR 1.494 OR 1.495" (Form PCT/DO/EO/903) indicating that applicant had met the filing requirements of 35 U.S.C. 371(c).

On 29 April 2002, applicant filed a status request concerning this application.

U.S. Serial No.: 10/009,138

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DISCUSSION

1077 OG 13 indicates:

"The Patent and Trademark Office is continuing to receive application papers which do not clearly identify whether the papers (1) are being submitted to enter the national stage of the Patent Cooperation Treaty (PCT) under 35 U.S.C. 371 or (2) are being filed as a regular national application under 35 U.S.C. 111..."

If there are any conflicting instructions as to which section of the statute (371 or 111) is intended the application will be accepted under 35 U.S.C. 111. It is strongly recommended that applicant use the Form PTO-1390 in all cases where a filing under 35 U.S.C. 371 is intended."

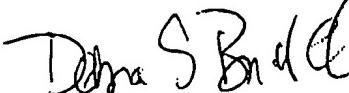
In the case of conflicting instructions, the application is to be treated as a filing under 35 U.S.C. 111. In this application, although applicant used the "Transmittal Letter for the United States Designated Office" (Form PTO-1390) as the transmittal letter, applicant also included a preliminary amendment, in which applicant indicates in the opening statement of the remarks that this application was a divisional application of an earlier filed application. Therefore, due to the conflicting instructions, this application should have been treated as a filing under 35 U.S.C. 111.

CONCLUSION

The a "NOTIFICATION OF ACCEPTANCE OF APPLICATION UNDER 35 U.S.C. 371 AND 37 CFR 1.494 OR 1.495" (Form PCT/DO/EO/903) mailed 31 January 2003 is hereby VACATED.

This application is being forwarded to the Office of Initial Patent Examination for processing of this application in accordance with this decision.

Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.


Debra S. Brittingham
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PCT Legal Office
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Conferee:


Richard Cole
PCT Legal Examiner
PCT Legal Office



Commissioner for Patents
Washington, DC 20231
www.uspto.gov

APPLICATION NUMBER	FILING DATE	GRP ART UNIT	FIL FEE REC'D	ATTY.DOCKET.NO	DRAWINGS	TOT CLAIMS	IND CLAIMS
10/009,138	11/26/2001	3731	420		18	14	3

Haviv Toledano
Metzman David
693 Downing Street
Teaneck, NJ 07666

CONFIRMATION NO. 8246

FILING RECEIPT



OC00000009431539

Date Mailed: 01/31/2003

Receipt is acknowledged of this regular Patent Application. It will be considered in its order and you will be notified as to the results of the examination. Be sure to provide the U.S. APPLICATION NUMBER, FILING DATE, NAME OF APPLICANT, and TITLE OF INVENTION when inquiring about this application. Fees transmitted by check or draft are subject to collection. Please verify the accuracy of the data presented on this receipt. If an error is noted on this Filing Receipt, please write to the Office of Initial Patent Examination's Filing Receipt Corrections, facsimile number 703 -746-9195. Please provide a copy of this Filing Receipt with the changes noted thereon. If you received a "Notice to File Missing Parts" for this application, please submit any corrections to this Filing Receipt with your reply to the Notice. When the USPTO processes the reply to the Notice, the USPTO will generate another Filing Receipt incorporating the requested corrections (if appropriate).

Applicant(s)

Haviv Toledano, Bialik, ISRAEL;

Domestic Priority data as claimed by applicant

This application is a 371 of PCT/IB97/00887 07/17/1997

Foreign Applications

Projected Publication Date: None, application is not eligible for pre -grant publication

Non-Publication Request: No

Early Publication Request: No

**** SMALL ENTITY ****

Title

Flexible annular stapler for closed surgery of hollow organs

Preliminary Class

606



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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APPL NO.	FILING OR 371 (c) DATE	ART UNIT	FIL FEE RECD	ATTY.DOCKET NO	DRAWINGS	TOT CLMS	IND CLMS
10/009,138	11/26/2001	3731	420		18	15	3

Haviv Toledano
c/o David Metzman
693 Downing Street
Teaneck, NJ 07666

CONFIRMATION NO. 8246

FILING RECEIPT



OC000000014621113

Date Mailed: 11/30/2004

Receipt is acknowledged of this regular Patent Application. It will be considered in its order and you will be notified as to the results of the examination. Be sure to provide the U.S. APPLICATION NUMBER, FILING DATE, NAME OF APPLICANT, and TITLE OF INVENTION when inquiring about this application. Fees transmitted by check or draft are subject to collection. Please verify the accuracy of the data presented on this receipt. If an error is noted on this Filing Receipt, please write to the Office of Initial Patent Examination's Filing Receipt Corrections, facsimile number 703-746-9195. Please provide a copy of this Filing Receipt with the changes noted thereon. If you received a "Notice to File Missing Parts" for this application, please submit any corrections to this Filing Receipt with your reply to the Notice. When the USPTO processes the reply to the Notice, the USPTO will generate another Filing Receipt incorporating the requested corrections (if appropriate).

Applicant(s)

Haviv Toledano, Kiryat Bialik, ISRAEL;

Power of Attorney: None

Domestic Priority data as claimed by applicant

This application is a DIV of 09/214,039 12/28/1998 ABN
which is a 371 of PCT/IB97/00887 07/17/1997

Foreign Applications

If Required, Foreign Filing License Granted: 11/26/2004

The country code and number of your priority application, to be used for filing abroad under the Paris Convention, is US10/009,138

Projected Publication Date: 03/10/2005

Non-Publication Request: No

Early Publication Request: No

**** SMALL ENTITY ****



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WASHINGTON, D.C. 20231
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APPLICATION NUMBER	FILING DATE	GRP ART UNIT	FIL FEE REC'D	ATTY.DOCKET.NO	DRAWINGS	TOT CLAIMS	IND CLAIMS
09/846,362	05/02/2001	3721	409	796/6	18	26	2

CONFIRMATION NO. 4164

FILING RECEIPT



OC000000008223238

DR. MARK FRIEDMAN LTD.
C/O ANTHONY CASTORINA
SUITE 207
2001 JEFFERSON DAVIS HIGHWAY
ARLINGTON, VA 22202

Date Mailed: 06/25/2001

Receipt is acknowledged of this nonprovisional Patent Application. It will be considered in its order and you will be notified as to the results of the examination. Be sure to provide the U.S. APPLICATION NUMBER, FILING DATE, NAME OF APPLICANT, and TITLE OF INVENTION when inquiring about this application. Fees transmitted by check or draft are subject to collection. Please verify the accuracy of the data presented on this receipt. If an error is noted on this Filing Receipt, please write to the Office of Initial Patent Examination's Customer Service Center. Please provide a copy of this Filing Receipt with the changes noted thereon. If you received a "Notice to File Missing Parts" for this application, please submit any corrections to this Filing Receipt with your reply to the Notice. When the USPTO processes the reply to the Notice, the USPTO will generate another Filing Receipt incorporating the requested corrections (if appropriate).

Applicant(s)

Haviv Toledano, Kiryat Bialik, ISRAEL;

Domestic Priority data as claimed by applicant

THIS APPLICATION IS A CON OF 09/214,039 12/28/1998

Foreign Applications

EUROPEAN PATENT OFFICE (EPO) PCT/IB97/00887 07/17/1997

If Required, Foreign Filing License Granted 06/25/2001

Projected Publication Date: 10/04/2001

Non-Publication Request: No

Early Publication Request: No

**** SMALL ENTITY ****

Title

Flexible annular stapler for closed surgery of hollow organs

10SX
8-95)

FILING RECEIPT



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
ASSISTANT SECRETARY AND COMMISSIONER
OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NUMBER	FILING DATE	GRP ART UNIT	FIL FEE REC'D	ATTORNEY DOCKET NO.	DRWGS	TOT CL	IND CL
08/687,315	07/25/96	3204	\$673.00	796/1		18	40

MARK FRIEDMAN AND CO
 ROBERT SHEINBEIN
 2940 BIRCHTREE LANE
 SILVER SPRING MD 20906

Receipt is acknowledged of this nonprovisional Patent Application. It will be considered in its order and you will be notified as to the results of the examination. Be sure to provide the U.S. APPLICATION NUMBER, FILING DATE, NAME OF APPLICANT, and TITLE OF INVENTION when inquiring about this application. Fees transmitted by check or draft are subject to collection. Please verify the accuracy of the data presented on this receipt. If an error is noted on this Filing Receipt, please write to the Application Processing Division's Customer Correction Branch within 10 days of receipt. Please provide a copy of the Filing Receipt with the changes noted thereon.

Applicant(s)

HAVIV TOLEDANO, KIRYAT BIALIK, ISRAEL.

* SMALL ENTITY *

TITLE
 FLEXIBLE ANNULAR STAPLER FOR CLOSED SURGERY OF HOLLOW ORGANS

PRELIMINARY CLASS: 227